

REMARKS

6. Upon entry of the present Amendment, Claims 1-21 are present in the case. In view of the present remarks, applicants request entry of the present amendment, reconsideration and withdrawal of the rejections and objections of the pending office action, and allowance of all claims present in the case at an early date.

7. Claim 1 and Claim 5, depending from Claim 1, are rejected under 35 USC 102(e) as anticipated by U. S. Patent No. 6,241,366 to Roman, et al, (hereinafter "Roman"), cited in the original office action. Applicants note that the explanation of the selection of the statute for this rejection again includes the erroneous statement that the application was not filed on or after November 29, 2000, but applicants proceed with responding to the rejection below. Independent Claim 20 is rejected under 35 USC 102(b) as anticipated by U. S. Patent No. 4,468,720 to Arai (hereinafter "Arai"), cited in the pending office action. Claim 2 depending from Claim 1 is rejected under 35 USC 103(a) based on Roman as applied to Claim 1, taken in view of reference C1, Wendelighting Model 1180 Optical Projector Track Lighting System (hereinafter "C1"), cited by the applicants. Claim 3 depending from Claim 1 is rejected under 35 USC 103(a) based on Roman as applied to Claim 1, taken in view of Arai.

8. Claims 4 and 6-10, depending directly or indirectly from Claim 1, are objected to as being dependent upon a rejected base claim, but are indicated as being allowable if rewritten in independent form.

9. Applicants note with appreciation the indication of allowance of Claims 11-19 and 21, including independent Claims 11, 16 and 21. Comments regarding the analyses provided by the office action supposedly supporting the allowance of these claims are given below.

10. In the rejections of Claims 1 and 5 the office action alleges that Roman discloses a housing 12 that receives a mounting assembly comprising a frame having an annular flange, which is asserted to be 18, and two retainer walls extending perpendicularly to the plane of the flange and parallel to each other on opposite sides of the opening defined by the flange. In fact, Roman describes a yoke 14 comprising a metal frame 18 (column 3, lines 24-31). Both the yoke 14 and the frame 18 display generally a squared "C" shape with the frame 18 positioned within the area of the "C" of the yoke 14. Neither the yoke 14 nor the frame 18 is annular. When one looks for the two retainer walls discussed by the office action, one sees the two arms of the frame 18, or the two arms of the yoke 14, that help to define the respective "C" shapes. In either case, the "retainer arms" do not extend perpendicularly to the plane of the flange, since they by

definition lie in the plane defined by either the yoke 14 or the frame 18. Further, the housing 12 does not receive the mounting assembly as described by the office action. In fact, the housing 12 is the housing of the luminaire 10 itself, and is received by the mounting assembly. Additionally, what the office action refers to as "a light beam contour mask" at 86 is identified as Roman's color filters (column 4, line 23).

11. By contrast, Claim 1 describes a mounting assembly that is received by a housing, and a contour light projector that is mounted on the mounting assembly. Thus, Roman fails to disclose a housing that receives a mounting assembly, the mounting assembly comprising a frame having an annular flange and two retainer walls extending perpendicularly to the plane of the flange and parallel to each other on opposite sides of the opening defined by the flange, and a light beam contour mask. In summation, Roman fails to disclose most of the features of Claim 1, and, therefore, does not anticipate that claim. Therefore, the rejection of Claim 1 should be withdrawn.

12. Applicants assert that the meaning of Claim 1 is clear on its face and that the office action is incorrect in its interpretation of the words "received" and "annular." It might be instructive for the Office to refer to the embodiments of the application to see how the claim language reads on them. Note, for example, Figs. 23 and 24, and the description that extends from page 20, line 17 through page 21, line 12. The structure includes a housing comprising a box, or enclosure, 152, and a mounting assembly 14A that is positioned within the box to hold the light projector 12, that is, a mounting assembly that is received by the housing, and a contour light projector that is mounted on the mounting assembly, as described in Claim 1. The mounting assembly does not receive the housing, as is the case in the Roman reference as employed by the office action. Further, Webster's Ninth New Collegiate Dictionary, Merriam-Webster, Inc., 1983, at page 982, provides the pertinent definition of "receive" as "to act as a receptacle or container for." The language of Claim 1, the disclosure of the invention, and the dictionary are all consistent regarding the meaning of "received by," and that meaning is the direct opposite of the meaning attempted and relied on by the office action in basing the rejection of Claim 1 on the Roman reference. Similarly, reference to Fig. 18 and the description given at page 15, line 22 through page 16, line 1 reveals that the mounting assembly 14 has a frame 106 that includes an annular flange 110 and two retainer walls 112 and 114. "The retainer walls 112 and 114 are on opposite sides of the space within the flange 110, and perpendicular to the plane of the flange" (emphasis added). It can be seen that the flange 110 is annular, defining an opening that is the "space within the flange," and that the two retainer walls 112 and 114 are on opposite sides of this space. All of this detail is consistent with the

clear meaning of Claim 1. Further, the same dictionary reference provides, at page 88, a consistent definition for the word "annular" as "of, or relating to, or forming a ring." By contrast, neither the yoke 14 nor the frame 18 of Roman can be said to be "annular."

13. The office action does not include any additional argument to support the rejection of Claim 5 based on Roman, but considers Roman as applied to the rejection of Claim 1. The discussion of Roman above applies also to Claim 5, in addition to which discussion one further considers the disclosure of Roman. The yoke 14 of Roman, supposedly serving as the frame of the claim, cannot be rotated in any plane defined by the frame 18 of Roman, supposedly serving as the flange of the claim, and which is connected to the yoke by a bracket 20 (column 3, lines 30 and 31). The yoke 14 "may be suspended from a supporting truss (not shown) by means of a clamp (also not shown) attached to yoke 14 at connector 16" (column 3, lines 24-29). Presumably the yoke 14 may be rotated about the central axis of the connector 16, but that rotation is perpendicular to the plane defined by the "C" shape of the frame 18. Once again, Roman fails to disclose features of the claim, and therefore does not anticipate that claim. Therefore, the rejection of Claim 5 should be withdrawn.

14. In the rejection of Claim 20 the office action alleges that the projector mask disclosed by Arai comprises "a plurality of shutter blades arrayed about the central axis of a holding ring ... and held between the ring and a seating surface ... wherein each blade has a concave edge toward the central axis of the holding ring, and wherein each blade has a tab, and one blade has two tabs extending laterally in opposite directions from that blade," and refers to Figs. 2 and 3 of the reference. To begin, Figs. 2 and 3 do not show the same structure. Fig. 2 is showing prior art to Arai comprising four mask plates with each plate having a straight edge toward the central axis of the arrangement, and each blade having only one operating knob. Figs. 3-5 are intended to show the improvement of Arai, including the variable mask device 20. Again, four mask plates 23 are used, having four operating knobs 24. The exact shape of each of the plates 23 is difficult if not impossible to discern from Fig. 4. In any event, Arai discloses four plates 23 (column 3, lines 50-56) and four knobs 24 (see Fig. 3 which illustrates at least three of the knobs). Thus, Arai does not disclose one blade having two tabs extending laterally in opposite directions from that blade, as described in Claim 20. In particular, the two tabs of the present invention enable manipulation of the double-tabbed blade and mounting of the light projector in situations not readily available with a single tab oriented perpendicular to the direction defined by the orientation of the two tabs. See page 12, lines 20-25 of the application. In

summation, Arai fails to disclose at least one of the features of Claim 20, and therefore, does not anticipate that claim. Therefore, the rejection of Claim 20 should be withdrawn.

15. Again, the office action bases the rejection of Claim 2, in part, on Roman as applied to the rejection of Claim 1, and therefore the discussion of Roman given above in relation to the rejection of Claim 1 applies also to the rejection of Claim 2 which depends from Claim 1. Further, consider the disclosure of C1. Claim 2 recites "an optical bench ... which comprises an elongate base to which at least one clamp is attached to hold the lamp and the condensing lens." The office action asserts that all of this is included in the disclosure of C1. However, that is not the case. C1 shows what appears to be two condensing lenses held on some kind of structure, and the lamp independently mounted in the housing, but not mounted on the same structure as the condensing lenses. Finally, the office action asserts that it would have been obvious "at the time the invention was made to have the light projector as disclosed by ...[C1] implemented in the instant invention." However, issues to be resolved are (1) whether it would have been obvious to modify the disclosure of Roman by incorporating the selected features of C1, and (2) whether such a combination would then provide the present invention as defined in Claim 2. Regarding the first issue, it does not seem possible, or at the very least obvious, how one would combine the structure holding the condensing lenses in C1 with the rotating lens devices 87 and 88, for example, or any of the other optical devices, of Roman. How would you do it? What would be the advantage that would inspire such a combination if it could be achieved? What is it in each of the references Roman and C1 that lead one to contemplate such a combination? As to the second issue, such a combination of Roman and C1, even if it could be constructed, would still not provide the invention as defined in Claim 2 in view of the failure of Roman to anticipate the invention as defined in Claim 1, and the failure of C1 to provide all of the additional limitations recited in Claim 2. Thus, Roman taken in view of C1 fails to render the invention as defined in Claim 2 obvious under the statute, and therefore the rejection of Claim 2 should be withdrawn.

16. The office action bases the rejection of Claim 3, in part, on Roman as applied to the rejection of Claim 1, and therefore the discussion of Roman given above in relation to the rejection of Claim 1 applies also to the rejection of Claim 3 which depends from Claim 1. Further, the discussion of Arai given above in relation to the rejection of Claim 20 also applies to the rejection of Claim 3, since the additional features recited in Claim 3 are the features combined with a contour light projector in Claim 20. Additionally, one is again faced with the issues of (1) whether it would have been obvious to modify the disclosure of Roman by incorporating the selected features of Arai, and (2) whether such a combination

would then provide the present invention as defined in Claim 3. As to the first issue, one must consider the purposes sought to be served by the two referenced disclosures. Roman discloses a "diffusing dimmer ... to gradually diffuse and eventually block a light beam ...[and to also provide] a strobing effect." See the Abstract of Roman. On the other hand, Arai discloses a "variable mask device" to control the focusing of light over an area to be illuminated. See, for example, column 1, lines 46-51. Why, then, would one remove the diffusing elements from Roman and incorporate the masking features of Arai? The result would be a device that does not fulfill the purpose of Roman. Therefore, such a combination would not be obvious to construct. Secondly, such a combination would still not provide the invention as defined by Claim 3 in view of the failure of Roman to anticipate the invention as defined in Claim 1, and the failure of Arai to provide all of the additional limitations recited in Claim 3. Thus, Roman taken in view of Arai fails to render the invention as defined in Claim 3 obvious under the statute, and therefore the rejection of Claim 3 should be withdrawn.

17. Further with respect to the rejections of Claims 2 and 3, the examiner has the burden of presenting a *prima facie* case of unpatentability which requires the examiner to produce a factual basis for rejections of claims under 35 USC §103. A rejection for obviousness based on a combination of references requires that there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. The office action relies only on the alleged disclosures of the cited references for the motivation. No other conceivable source of motivation is suggested by the office action. Although the office action includes the wording "ordinary skill in the art," the office action does not make a factual finding of that level of skill, and does not explain how or why a person having that level of skill and who does not possess knowledge of the claimed invention would be led to the cited references, and does not explain how that person would be inspired or motivated by the references or anything else to make a combination of parts taken from the references to attempt to achieve the claimed invention. Significantly, the office action fails to identify and explain what it is in each of the cited references that supposedly constitutes the required motivation or suggestion to select specific features from the disclosures of the secondary references C1 or Arai, and combine those features with the Roman apparatus. The lack of such specificity in the office action leaves applicants with no stated reasoning or factual presentation in support of the rejections, to which the applicants can respond. To merely list the secondary references C1 or Arai as asserted sources of parts missing from the primary reference Roman, and to rely on "ordinary skill in the art" in an attempt to make a combination to achieve the claimed invention, and thus declare the claims obvious

is, at best, effectively using the claims as a plan or model, that is, using hindsight based on the claimed invention itself.

18. Applicants conclude that the office action fails to present a case for obviousness under 35 USC 103 for either of Claims 2 or 3, and, therefore, the rejections of these claims should be withdrawn. Additionally, each of these two claims depends directly from Claim 1 which is in condition for allowance as argued above.

19. While applicants acknowledge the indication of allowance of Claims 11-19 and 21 above, there appear to be some shortcomings in the comments of the office action provided in relation to these claims. The allowed claims include independent Claims 11, 16 and 21. The office action discussion of the allowed claims includes three bulleted paragraphs on pages 5 and 6 thereof. The second of these paragraphs beginning on page 5 and extending to page 6 appears to simply recite features of Claim 16, and the third bulleted paragraph on page 6 appears to recite features of Claim 21. However, the first bulleted paragraph appearing on page 5, which is presumably offered in explanation of the allowance of Claim 11, recites the features added to Claim 1 by Claim 6 which depends from Claim 1. Applicants do not understand why the additional features of Claim 6 are recited in connection with the statement of the allowance of Claims 11-19 and 21. Applicants are further mystified that the mere recitation of features of Claims 16 and 21 without further comment distinguishing these claims from the prior art, for example, is given as explanation for the allowance of these claims. While applicants agree that the claims are allowable, if the office action is going to give reasons for their allowance, then these reasons should be explicitly stated.

20. The remaining references of U. S. Patent No. 6,206,544 to Costa and U. S. Patent No. 4,636,925 to Kristofek listed in the office action of December 19, 2002 have been considered, but are not deemed to anticipate the claims or to render the claims obvious under the statute.

21. Based on the foregoing analysis applicants respectfully assert that all Claims 1-21 are in condition for allowance. Therefore, applicants earnestly request withdrawal of all rejections and objections, and allowance of all Claims 1-21 at an early date. If anything further is required to place the entire application in condition for allowance, the examiner is respectfully requested to telephone the undersigned representative.

22. A Change of Attorney's Address is being separately submitted to provide the new address listed below. Please direct all correspondence to the new address. The telephone and facsimile numbers remain unchanged.

Respectfully submitted,

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